

Appl. No. : 10/827,095
Filed : April 19, 2004

REMARKS

In response to the Office Action mailed May 10, 2005, Applicant respectfully requests the Examiner reconsider the above-captioned application in view of the following comments and the enclosed Terminal Disclaimer. Claims 1 and 10-16 remain pending in the present application.

Rejection of Claims 1 and 10-16 for Double Patenting

The Office Action rejected Claims 1 and 10-16 under a non-statutory, obviousness-type double patenting rejection. While Applicant may not agree with the foregoing rejection, in order to progress the prosecution of the present application, Applicant is submitting an appropriate Terminal Disclaimer. Accordingly, Applicant respectfully requests withdrawal of the non-statutory, obviousness-type double patenting rejection of the claims.

35 U.S.C. §103(a) Rejection

The Office Action rejected Claims 10 and 12 under 35 U.S.C. §103(a) as being unpatentable over Huang (5,797,813) in view of Huang (6,386,989). Applicant respectfully disagrees with this rejection. Claim 10 presently claims a golf club grip comprising, among other limitations, a heat formed recessed reinforcement surface formed on a first side edge of the polyurethane layer and a heat compressed non-recessed densified area formed on the second side edge of the polyurethane layer;

The '813 reference discloses a heat formed recessed reinforced surface formed on both first and second side edges of a polyurethane layer. These recessed edges are designated 42 and 44, respectively, and are illustrated in Figure 8 of the '813 reference, among other places. However, as illustrated in Figures 18-20 of the '813 reference, the use of dual overlapping recessed reinforced side edges results in a grip that includes a groove defined by the outer recessed reinforced side edge. Applicant's presently claimed invention eliminates such a groove by providing, among other things, "a heat compressed non-recessed densified area formed on the second side edge of the polyurethane layer" rather than a second recessed reinforcement surface. Applicant's claimed strip is "adapted to be spirally wrapped about the sleeve with the second side edge of the strip overlying the first side edge of the strip to form a relatively smooth surface." As such, the '813 reference does not teach or suggest Applicant's claimed grip.

Further, the '989 reference does not include any teaching that could be used to modify the disclosure of the '813 reference to render obvious the invention claimed in Claim 10 of the

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present application. Figures 9 through 13 of the '989 reference show a grip similar to the one in the '813 reference. The grip appears to include a groove. Applicant submits that nothing in the prior art of record discloses the grip claimed in Claim 10 and respectfully requests withdrawal of the present rejection.

Incidentally, Applicant notes that the Office Action rejected Claim 10 as being unpatentable over the '813 reference in view of the '989 reference. However, the Office Action appears to only rely upon the '813 reference to reject Claim 10. As discussed above, neither the '813 reference nor the '989 reference, taken alone or in combination, teaches or suggests Applicant's grip as claimed in Claim 10.

Claim 12 depends upon Claim 10. As such, for at least the reasons discussed above, Claim 12 is patentable over the prior art of record and Applicant respectfully request's withdrawal of the present rejection.

Allowable Subject Matter

Applicant would like to thank Examiner Blau for the indication of allowable subject matter in Claims 1, 11, and 13-16. In view of the Terminal Disclaimer filed concurrently herewith and the arguments presented above, Applicant submits that these claims are now in condition for allowance.

Comments on Examiner's Reasons for Allowance

Applicant respectfully disagrees with the Examiner's stated reasons for allowance to the extent that the Examiner's reasons imply that the patentability of any claim rests on the recitation of a single structure or method step because it is the combination of features and steps recited in each claim that makes that claim patentable.

Applicant notes that numbered paragraph 6 of the Office Action appears to support the proposition that the prior art does not teach a spirally wrapped grip with a relatively smooth surface. "With respect to claims [sic] 1, none of the prior art discloses or renders as obvious a relatively smooth junction between first and second side edges in addition to the other elements of structure claimed." However, Applicant respectfully notes that Claim 1 includes the limitation "the second side edge of the strip adapted to overlap the first side edge of the strip to form a smooth watertight juncture between such first and second side edges of the strip." Applicant maintains that this limitation, in combination with the other limitations recited in Claim 1,

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renders Claim 1 patentable over the prior art of record. Claim 10 recites "the strip adapted to be spirally wrapped about the sleeve with the second side edge of the strip overlying the first side edge of the strip to form a relatively smooth surface." Applicant maintains that this limitation, in combination with the other limitations recited in Claim 10, renders Claim 10 patentable over the prior art of record.

Applicant further disagrees with the Examiner's comments to the extent that they characterize the language recited in the claims. Applicant notes that it is the claim language, and not the Examiner's interpretation of that language, that defines the scope of the claimed invention. Applicant suggests that, for the reason presented in numbered paragraph 6 of the Office Action, among other reasons, Claim 10 is patentable over the prior art of record. Applicant's suggestion is subject to the above caveats regarding the Examiner's characterization of the language recited in the claim and any suggestion that patentability rests on any one limitation alone.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims and specification. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.


The undersigned has made a good faith effort to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Edward A. Schlatter, at (949) 721-2821 (direct line), to resolve such issues promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: September 12, 2005

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